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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
PTB-**4942-5**

Application Number	Filed
10/531,260	April 13, 2005

First Named Inventor
TARBELL et al.

Art Unit	Examiner
2164	Yuk Ting Choi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request, although an Amendment After Final Rejection (simply canceling claims) was filed just prior to filing this Request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
     Note: No more than five (5) pages may be provided.

I am the
- ☐ Applicant/Inventor

- ☐ Assignee of record of the entire interest. See 37
    C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b)
    is enclosed. (Form PTO/SB/96)

- ☒ Attorney or agent of record   38,009
                          (Reg. No.)

- ☐ Attorney or agent acting under 37CFR 1.34.
  Registration number if acting under 37 C.F.R. § 1.34 _____

         /Paul T. Bowen/
             Signature

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         703-816-4019
    Requester's telephone number

       March 10, 2009
           Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of   1   form/s are submitted.

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STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

The application includes two independent claims (claims 46 and 68). Claim 46 is directed to a computer implemented method of journaling in a database journal changes to system objects in an operating system with a processor, the method including i) executing a dummy function in place of a system function when the system function is called, ii) executing the system function under operation of the dummy function, and generating copies of system objects, changed by the execution of the system function, for journaling.

Claim 68 is directed to a system for journaling in a database journal changes to system objects including i) a processor adapted to execute a dummy function in place of a system function when the system function is called, wherein the dummy function executes the system function and generates copies of system objects resulting from the execution of the system function execution for journaling, and ii) memory for use by the processor during execution.

The claimed subject matter provides significant advantages over the journaling prior art in that journaling changes are able to be made without being restrained to the journaling of particular objects, whereas the journaling prior art is focused on journaling system objects only for a portion of defined objects. Reference is made to the "Background of the Invention" section of the application which provides a clear discussion of the problems with the prior art. From this prior art description, it is clear that the present disclosure provides a useful solution in the art of database journaling that was clearly not available prior to its inception, i.e., that of providing a general manner of creating journaling functionality without being restrained to particular defined objects.

In the final rejection, independent claims 46 and 68 are rejected under 35 U.S.C. §103(a) over Tanaka et al. (U.S. Patent No. 6,665,735), in view of Bills et al. (U.S. Patent Publication No. 2003/0204479 A1).

As admitted in the Office Action, Tanaka et al. does not explicitly disclose a method of journaling changes to system objects and generating copies of the system objects for journaling. See page 6 of the Office Action.

To make up for this deficiency, the final rejection relies on Bills et al.

However, as made clear in Applicants' July 11, 2008 response, Bills et al. does not teach or suggest the claimed subject matter missing from Tanaka et al. Rather, Bills et al. teaches a method of recording data changes to objects. The method includes the steps of determining if there is an indication within the object that any changes to that object should

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be stored in the object. If there is such a determination, then the changes are stored only in a journal entry in a journal. Therefore, Bills et al. is not concerned with the storing objects after they have changed, but instead is solely concerned with avoiding storing those changed objects. This is clearly different than the subject matter of claims 46 and 68 wherein copies of system objects are changed by the execution of a system function, and those changed system objects are generated for journaling. Therefore, Bills et al. does not disclose generating copies of system objects, changed by the execution of the system function, for journaling, as recited in claims 46 and 68.

In the Final Rejection (part 3.a)), the Examiner disagrees with the Applicants' arguments because the Examiner interpreted the phrase "generating copies of system objects" as "generating copies of changes of system objects". The Examiner apparently justified this unreasonable interpretation of the claim language based on Applicants' specification which is said to clearly indicate that the exit program may handle execution of the system function and capture changes to system objects occurring during the execution. Copies of changes are generated by the exit program and saved to disks for journaling (see page 3, line 35 and page 4, lines 1-3). Applicants also disclose copies of changes that are generated by the dummy function (page 4, lines 4-8). Thus, the Examiner concludes that it is entirely reasonable for the Examiner to read "generating copies of system objects" as "generating copies of changes to system objects".

Applicants respectfully submit that the Examiner's rejection/interpretation is improper. The express language of claim 46 requires a method in which the system function is executed under operation of the dummy function and copies of system objects, changed by the execution of the system function, for journaling, are generated. The Examiner's interpretation of the claimed phrase "generating copies of system objects" as "generating copies of changes to system objects" is inappropriate since the Examiner's interpretation is inconsistent with the express language of the claims, especially considering the meaning of the claimed phrase as defined in the present specification. While journaling copies of changed system objects records system objects, journaling copies of changes to system objects according to Bills et al. does not result in recording the system object, as claimed.

Moreover, the Examiner's interpretation is even less appropriate when the specification and claims also distinguish the copying of changes to system objects (claim 65). Specifically, the specification and claims draw a line of distinction between the copying of changes to system objects versus the copying of system objects after changing. However, the

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Examiner (see part 3.a) of the Final Rejection) improperly uses Applicants' own specification in order to reject the claims.

In paragraphs 10, 11 and 12, various dependent claims have been further rejected under the basic Tanaka et al./Bills et al. combination, and further in view of Owen (U.S. Patent Publication No. 2003/0217031 A1) and Suzuki (U.S. Patent No. 6,829,768). However, neither Owen nor Suzuki makes up for the deficiencies noted above in regard to Tanaka et al. and Bills et al., and none were relied upon for such.

Moreover, the rejection of claim 67 appears improper on its face since it is based on a combination of Bills et al. in view of Cloud (U.S. Patent No. 6,253,369) whereas claim 67 depends from claim 65, which in turn depends from claim 46. As the rejection of claim 46 is based on the combination of Tanaka et al. in view of Bills et al., it appears that the rejection of claim 67 which is rejected based on the combination of Bills et al. and Cloud is improper. Moreover, Cloud does not make up for the deficiencies noted above in respect to Bills et al. (or Tanaka et al.) and nor was it relied upon for such.

Claims 90-93 were rejected under 35 U.S.C. §101.

The Panel is referred to the March 10, 2009 Amendment After Final Rejection in which claims 92 and 93 are canceled thereby rendering the rejection moot. In regard to claims 90 and 91, Applicants respectfully traverse the rejection since the claims specifically set forth a computer readable storage medium tangibly storing software. Thus, the premise of the rejection that the claims are directed toward a computer readable storage medium possibly encompassing a "signal" is incorrect, as one of ordinary skill in the art would understand the claimed software storage medium as encompassing, e.g., a disk, a CD-ROM, or DVD-ROM or the like. Moreover, claims 90 and 91 are in a format made expressly acceptable in the case *In re Beauregard*, which was later referred to in the Board's post-*Bilski* decision of *Ex parte Bo Li*, Appeal 2008-1213, decided on November 6, 2008 at p. 9.

In view of the fact that each of claims 90 and 91 is a "Beauregard claim", claims 90 and 91 are directly analogous to *Ex parte Bo Li*. Thus, claims 90 and 91 clearly are directed to statutory subject matter.

To make abundantly clear that the claims are directed to statutory subject matter, Applicants are willing to further amend claims 90 and 91 to specify that the software is <u>executable by a computer</u>, although this appears unnecessary given the case law and how one of ordinary skill in the art would read and understand the claims.

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As a result of the above, there is simply no support for the rejection of Applicants' claims. Applicants respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims.